

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 11-20 are pending for examination in this application. Claims 1-10 were previously canceled without prejudice or disclaimer.

The outstanding Office Action repeats the rejection of Claims 11-20 under 35 U.S.C. §103(a) as being unpatentable over Neary et al. (U.S. Patent No. 3,882,721 Neary) in view of Catagrel et al. (EPO 0100715, Catagrel) from the last Action mailed February 11, 2004.

REQUEST FOR WITHDRAWAL OF INCOMPLETE ACTION

The outstanding Action is incomplete because the "Response to Arguments" at page 4 of the outstanding Action does not reasonably consider and treat the specific arguments made in the response filed June 14, 2004.

In this regard, MPEP §707.07(f) requires that arguments made in a previous response must be answered when repeating a rejection. Here, it is clear that the outstanding Action repeats the rejection of Claims 11-20 at pages 2-4 (from and including the heading "DETAILED ACTION" to, but not including, the heading "Response to Arguments") presented in the Action mailed February 11, 2004, almost verbatim, adding only the language "Regarding claim 11," to the start of the first paragraph describing the teachings of Neary.

Even though the previous rejection has been repeated in almost an exact word for word fashion, the arguments presented in the response filed June 14, 2004, have been given a mere lip service consideration in the two paragraphs presented following the heading "Response to Arguments" at page 4 of the outstanding Action.

The first of these paragraphs begins by using form paragraph 7.37 (noted in MPEP §707.07(f)) to assert that all of the "arguments filed 6/14/04 have been fully considered but they are not persuasive." In using this form paragraph, the Action has failed to comply with

notes 1 and 2 that accompany this form paragraph in MPEP §707:07(f) in terms of first addressing “all arguments which have not already been responded to in the statement of the rejection,” and “[i]n bracket 2 , provide explanation as to non-persuasiveness. Instead of addressing all of the arguments presented in the above-noted last response or providing any explanation as to non-persuasiveness, the only other information presented by this first paragraph is a further form paragraph (7.37.04) acknowledgement that “the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in knowledge generally available to one of ordinary skill in the art” (citations omitted) that omits the required bracket 1 information as to the location of the reference teachings being relied upon.

Thus, nothing in either of these paragraphs addresses all the arguments of the above-noted last response filed, particularly those noting binding precedent requiring the PTO to present an explanation as to why the artisan would first select clearly disparate references for combination and why this artisan would then proceed to attempt a modification of either reference that is opposed to what that reference teaches and that would require a complete redesign thereof so as to change its basic operating principle.

Instead of addressing these and the other specific arguments of the above-noted last response or pointing to the required bracket 1 information for form paragraph 7.37.04 as to the location of the reference teachings being relied upon, the first sentence of the second of these above noted paragraphs simply presents a general summary of the asserted teachings of Catagrel and Neary. These non-specific generalizations are followed by a second and third sentence that together appear to suggest that the PTO has been authorized to determine that motivation to combine reference teachings is established whenever both references teach the that the subcombination elements of a claimed combination are known. This is exactly the

rationale dismissed as improper by the court in In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) as follows:

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir.1998). Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

REQUEST FOR RECONSIDERATION UNDER 37 CFR §1.116

The above-noted response filed June 14, 2004, presented the following unanswered arguments that are believed to clearly overcome the outstanding rejection and are, thus, repeated as follows:

Turning to the rejection of Claims 11-20 under 35 U.S.C. §103(a) as being unpatentable over Neary in view of Catagrel, the basis for asserting that there is any reasonable motivation to modify either reference by the teachings of the other is not clear.

In this respect, the vane of Neary is not hollow because it has an "embedded" heater wire 55 (col. 3, lines 39-41). Moreover, this heater wire 55 cannot be simply inserted through the base of the vane as the wire has to undergo two 180° changes in direction as clearly illustrated as to heater wire 55 shown inside the vane in FIG. 2. Also, the teaching of embedding at col. 3, lines 39-41 is specific to the heater wire being "cast in place" with the heater wire 55 of Neary being grounded to the vane at 56. As was noted in the response filed August 20, 2003, it is well established that "embed" means to "fix firmly in a surrounding mass or to enclose snugly or firmly, to make an integral part of." See again the page 447 definition of "embed" from the American Heritage Dictionary attached to that response. As further noted in this August 20 response, "hollow" can only be reasonably interpreted to mean that there is a cavity, gap or space present. This was also documented by the page 617 definition of "hollow" attached to that response.

These teachings of the thin single strand of heater wire to be embedded into the vane with no excess space inside the vane are critical to the vane of Neary because the purpose of Neary is to have a "quite thin" vane (col. 2, line

30) that is also light weight so as to have a high torque capacity without high inertia (see col. 4, lines 9-11 as well as col. 1, lines 26-29).

On the other hand, Catagrel clearly is not concerned with reducing the weight of the vane by using a light weight single wire as a heater to provide a high torque capacity without high inertia given the bulkiness of the heaters suggested by Catagrel. Moreover the use of the vane backside for heater insertion is clearly the antithesis of the Neary requirement for a “quite thin” vane as the backside hole has to be wide enough to accommodate heater insertion. Accordingly, while Catagrel can be said to teach insertion of a bulky heating element through large size holes in the rear surface of a vane that is relatively thick to accommodate the heater dimensions and a hollow space inside the vane to accommodate the large heater, the artisan would have had no reasonable basis to select the Catagrel reference for combination with Neary as the vane of Neary would not then operate as intended by Neary in terms of being a thin vane of light weight that has high torque capacity without high inertia. The PTO reviewing court requires the PTO to establish why the artisan would have some reasonable basis to select the references for combination. See In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) and In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Thus, the rejection is clearly misplaced because there has been no motivation established as to any reason why the artisan would have even selected these disparate references for combination, much less a reasonable basis to depart from the reference teachings and to enlarge the rotary base and torque arm 17 of Neary to permit forming a suitable passage there through large enough for the bulky Catagrel heater to be passed to an interior space in the vane forming a hollow heater compartment therein as further required by Catagrel.

Moreover, the rejection is clearly misplaced because the proposed combination would require an extensive modification to Neary that, if performed, would change the desired operating principal of Neary as to providing a light weight and thin vane having a high torque capacity without high inertia. Any proposed modification that would change the basic operating principle of a reference is not an obvious one. See In re Ratti, 123 USPQ 349, 352 (CCPA 1959).

Furthermore, modifying the vane of Neary as taught by Catagrel would not result in the claimed subject matter, even if this modification were to be done as taught by Catagrel. In this regard, the modification following the actual Catagrel teachings requires the use of the large rear surface of the vane for heater insertion. It is well established that reference teachings must be taken in the context presented in the entire reference. See In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

To the extent that the outstanding Action appears to suggest that either Neary or Catagrel suggest the heater insertion through the rotary base of Neary, this suggestion is without merit. The wire hole of Neary is clearly not taught to be used to insert the heating wire into any inner hollow of Neary as

fully discussed above as to this twice curved and embedded wire. Also, to whatever extent that Catagrel teaches heater insertion through a complementary shaped hole, this complementary shaped hole is on the wide rear face of the apparent vane of FIGS. 6-9. Further, it is clear that the rotary base hole of Neary and/or rotary base size of both Neary and Catagrel (FIGS. 6-9) are far too small and far too separated from the vane by the streamlined support (17 in Neary and 11 Catagrel) to provide a passage into the vane of the size and shape required by the Catagrel suggested heaters. Once again, the required showing of reasonable motivation to modify Neary to reach the claimed subject matter from only the teachings and suggestions of Catagrel and Neary is lacking and the rejection is clearly improper and should be withdrawn.

In addition, the further rationale treated above as to the non-specific generalizations offered as reference teachings (in the last paragraph at the bottom of page 4 of the outstanding Action, it is clear that both references are not teaching the alleged same principle of “heating elements located in the vane providing a flow of heat radiating throughout the vane.” A simple glance at FIG. 2 of Neary reveals that there is only one heating element taught and that this element cannot possibly provide “a flow of heat radiating throughout the vane” as alleged as the heater wire is shown to primarily heat only the front edge and top edge of the vane with there being no heater wire at all in the rearmost lower third of the FIG. 2 illustrated vane. The PTO is called upon to identify where in Neary it finds the alleged teaching of “heating elements located in the vane providing a flow of heat radiating throughout the vane.” See In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (“When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”).

Moreover, even though it can be said that Neary and Catagrel teach heaters in vanes, these teachings cannot be viewed in the abstract as the law requires that reference teachings are to be considered in the reference context, not in a vacuum. See In re Kotzab at 55 USPQ2d 1317 (Fed. Cir. 2000) as follows:

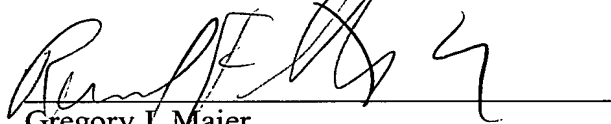
While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [reference statements] would have suggested to those of ordinary skill in the art, the [reference] statements cannot be viewed

in the abstract. Rather, they must be considered in the context of the teaching of the entire reference. Further, a rejection cannot be predicated on the mere identification in [a reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

As it is believed that no other issues remain outstanding in this application, it is further believed that this application is, accordingly, in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

Gregory J. Maier
Attorney of Record
Registration No. 25,599
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)